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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/359,809	07/23/1999	RICHARD LEVY	01064.0011-0	3299

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/359,809

Applicant(s)

LEVY, RICHARD

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 73-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2005 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 85-110 of copending Application No. 10/781,240. Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant composition of the present invention is the same composition used in the method of lubricating a

surface. Therefore, it would be reasonable to expect that the lubricant composition of the present invention would be used to lubricate a surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-115 of copending Application No. 10/763,687. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention are encompassed by the lubricant composition of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-90 of copending Application No. 10/614,114. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the present claims do not contain a substrate, it would be reasonable to expect that the lubricant composition would be applied to substrate such as in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 73 and 76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the language regarding a lubricating metal and alloy, lubricating metal oxide, nitride or carbonate. The specification is very specific about the metal compounds, metals, carbonates and nitrides. Applicant is claiming generic components when the specification only teaches zinc, cadmium, antimony or lead oxide; boron nitride and lead carbonate. With respect to the metal compounds and alloys thereof, Applicant disclosed babbitt, bronze, and brass, which are alloys and about 15 metals. Nowhere in the specification is it taught that every alloy and every metal is within the scope of the invention.

Claim 76 is rejected because the specification does not support all metal materials that provide barrier-layer lubrication.

Claim 89 is rejected because the specification does not support a substantially anhydrous composition.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 73, 77, 89 and 90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 73, it is not clear how the phosphates of (1) differ from those of (2).

Claim 77 is rejected because there is no antecedent support in claim 76 for disulfides, chlorides, selenides, sulfates, iodide and borax (sodium borate).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 73, 74, 76, 77 and 90 are rejected under 35 U.S.C. 102e as being anticipated by Takayama (US 5,792,717).

Takayama teaches a sliding material comprising a porous ceramic body that has open pores filled with a high water absorbing resin (see abstract). The ceramic body may be boron nitride and the resin may be crosslinked polyacrylates (see col. 4, lines 4-11; col. 5, lines 16-28). The resin absorbs at least 100 times its weight in water (see col. 4, lines 60-67). Takayama teaches that the composition has lubricity properties (see col. 4, lines 30-43).

Accordingly, Takayama teaching all the limitations of the claims anticipates the claims.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 73-76, 80-82, 86, 87, 89-93, 96, 99 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,275,760) in view of Obayashi (US 4,340,706).

Johnson teaches a gelled corrosion inhibitor comprising a gelling agent slurried in a first medium and a corrosion inhibitor dissolved in a second liquid medium, wherein the gelling agent forms a gel in the second liquid medium (see abstract; col. 3, lines 3-7). The gelling agents are water insoluble hydrogel-forming materials known in the art as superabsorbent polymers(see col. 3, lines 21-23, 31-68). The gelling agents are

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carried as a slurry in an oil such as fatty esters, mineral oils and lubricating oils (first medium). The corrosion inhibitor (lubricant additive) is dissolved in water (see col. 4, lines 39-55). The corrosion inhibitor may be alkali or alkaline earth metal carbonate (applicant's carbonate) (see col. 4, lines 44-48). Johnson teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Johnson differs from the claims in that he does not specifically teach applicant's intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

In the second aspect, Johnson differs from the claims in that he does not specifically teach that the super absorbent polymer absorbs greater than 100 times its weight in water. However, Obayashi teaches this difference. Obayashi teaches that the cross-linked neutralized polyacrylic acid taught by Johnson absorbs at least 400-800 times its weight in water (see abstract; col. 6, lines 42-66).

It would have been obvious to one of ordinary skill in the art to use the claimed polymers because Johnson teaches the use of superabsorbent polymers and Obayashi teaches that these polymers absorb greater than 100 times their weight in water.

In the third aspect, Johnson differs from the claims in that he does not specifically teach that the oils are polymerized olefins. However, no unobviousness is seen in this difference because Johnson teaches that hydrocarbon oils may be used in the invention and this broad teaching suggests polymerized olefins, which are hydrocarbon oils.

14. Claims 73, 74, 76, 89 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martineu (US 4,977,192).

Martineu teaches a granular polymer composition having water absorption wherein the composition comprises a water-insoluble but swellable cross-linked polymer material formed of at least one polymer from at least one carboxylic group and at least one powdered mineral charge (lubricating additive) and metal oxide (lubricating metal oxide) dispersed in and bonded to the polymer (see claim 1; col. 4, lines 8-10). The mineral materials include dolomite (a carbonate) and iron oxide (see col. lines 8-10). In Table IV, Martineu teaches that the polymers absorb from 100 to over 300% water.


Martineu teaches the limitations of the claims other than Applicant's intended use. However, intended use is given no patentable weight in claims that are directed to the composition per se.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cephia D. Toomer
Primary Examiner
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